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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,042	05/08/2001	Randy D. Petrea	5236	2161

7590                    08/09/2002

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[REDACTED]  
EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
1616	8

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/851,042	PETREA ET AL.
	Examiner	Art Unit
	Sharmila S. Gollamudi	1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 May 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 4-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Amendment A filed May 28, 2002 and the Extension of Time are acknowledged.

Claims 1 and 4-20 are included in the prosecution of this application.

Claims 2 and 3 are cancelled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Rejection of claims 1 and 7-16 under 35 U.S.C. 102(b) as being anticipated by Krall et al (5976562) is maintained.**

### ***Response to Arguments***

Applicant argues that Krall et al does not teach any films with the same silver-based antimicrobials as instant invention or the application of the antimicrobial within the interior of the film.

Applicant's arguments have been fully considered but they are not persuasive. The examiner points to column 4, lines 54-67 and column 2, lines 5-15, where Krall teaches not only coating the polyurethane film with the active substance (silver) but also the step of extruding the film so that the active substance is worked into the plastic. Further, Krall teaches coating the polyurethane film with elemental silver in example 1.

**Rejection of claims 1, 4, and 7-16 under 35 U.S.C. 102(b) as being anticipated by Capelli (5744151) is maintained.**

Applicant argues that Capelli teaches an adhesive film and not an anti-tack film as now amended.

Applicant's arguments have been fully considered but they are not persuasive. The examiner points out that claims 1, 4, and 7-16 do not recite an anti-tack limitation and merely claims an polyurethane film with an silver-based antimicrobial agent (silver nitrate), which is taught by Capelli in example 20. Further, the claim language does not exclude the tacky adhesive included by Capelli.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Rejection of claims 4-6 under 35 U.S.C. 103(a) as being unpatentable over Krall et al cited above, in view of JP 09002537 is maintained.**

#### ***Response to Arguments***

Applicant argues Krall does not teach a plastic coated film that comprises certain silver metal antimicrobials.

Applicant's arguments regarding Krall et al have been addressed above.

Applicant's arguments have been fully considered but they are not persuasive. In response to applicant's argument that although silver zirconium phosphate may provide color improvement, the unexpected anti-tack benefit is not taught, the fact that applicant has recognized another advantage which would flow naturally from following

the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Therefore, although JP provides a motivation to use silver zirconium phosphate different from applicant, it does not make the instant invention patentably distinct from the prior art. JP teaches that silver zirconium phosphate not only provides antimicrobial properties but also prevents deterioration and discoloration in polyurethane articles. Krall teaches a silver based antimicrobial agent in a polyurethane; therefore one of ordinary skill in the art could reasonably expect similar results using silver zirconium phosphate in Krall's composition. The examiner further points out that the claims are product/composition claims where the function of individual components is not given patentable weight.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., J JP merely states that silver zirconium functions well in plastic articles and not in ribbons, fibers, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the polyurethane film is in the preamble and is not given patentable weight in a composition claim and the intended use is not given patentable weight.

**Rejection of claims 1-16 under 35 U.S.C. 103(a) as being unpatentable over JP 11028797 in view of JP 09002537 are maintained.**

Applicant argues that the references do not teach the unique anti-tack feature of the instant invention.

Applicant's arguments have been fully considered but they are not persuasive. These arguments have been pointed out above that the claims, which are rejected, do not recite the anti-tack feature. Further, the new function of a component in a composition claims does not make it patentably distinct from the prior art.

**New Rejections in Light of Amendments**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krall et al cited above, in view of JP 09002537 in further view of Folden (5536258).**

As set forth above, Krall et al disclose a polyurethane film incorporating silver. Krall et al does not include an organic bactericide. JP 09002537 teaches a container incorporating silver based zirconium phosphate since it provides less discoloration and deterioration.

The references do not teach the polyurethane film having different tacky properties with the incorporation of silver.

Folden teaches antimicrobial medical tubing connector. Folden teaches the application of silver coatings for implantable medical devices are effective in preventing infection (col. 4, lines 49-63). Folden also teaches one advantage of using silver a coating is that it provides a smooth, durable, and low-friction surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that Krall's polyurethane film containing silver would exhibit different tacky properties than a film not containing silver since Folden teaches silver not only functions as an antimicrobial but also provides a low-friction surface.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

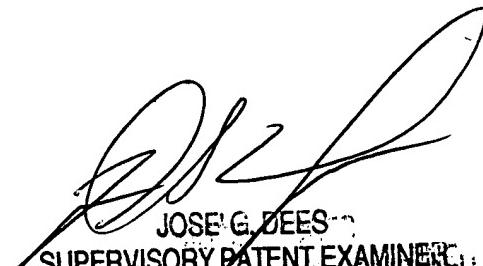
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 703-305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 709-308-0196.

SSG  
~~SSG~~  
August 2, 2002

  
JOSE G. DEES  
SUPERVISORY PATENT EXAMINER  
1616